

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Conf. No.: 3079	: Group Art Unit: 2161
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Appln. No.: 09/820,054	: Examiner: Etienne Pierre Leroux
	:
Filing Date: March 28, 2001	: Attorney Docket No.: 10397-1U1
	:
Title:	: SYSTEM AND METHOD FOR NETWORK ADMINISTRATION AND LOCAL ADMINISTRATION OF PRIVACY PROTECTION CRITERIA

COMMUNICATION REGARDING AMENDED APPEAL BRIEF

In response to the “Order Returning Undocketed Appeal to Examiner” mailed December 5, 2007, the attached pages show the changes made to the original Appeal Brief with additions shown with double underlining and deletions shown with strikethroughs.

Respectively submitted,

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AMENDED APPEAL BRIEF (37 C.F.R. § 41.37)

This brief is in furtherance of the Notice of Appeal, filed on August 7, 2006 in this case, ~~being filed in response to the Order Returning Undocketed Appeal Brief to Examiner mailed December 5, 2007.~~ The fees required under § 41.20 are dealt with in the accompanying "Transmittal of Appeal Brief," ~~were paid when the original Appeal Brief was filed and no additional fees are believed to be due.~~

In telephone calls held between Appellants' undersigned representative and Examiner Leroux on December 10 and 11, 2007, it was agreed that Appellants would first file an Amended Appeal Brief that addresses the items highlighted in the Order, the Examiner will respond with an Amended Examiner's Answer that clearly identifies the new grounds of rejection which relate only to dependent claims, and that Appellants would respond with an Amended Reply Brief that is identical in content to the originally filed Reply Brief, and that no request would be made to reopen prosecution in view of the new grounds of rejection.

In this Amended Reply Brief, the headings on pages 5, 10 and 12 now match grounds of rejection listed on page 5, and the two § 1.131 Declarations filed during prosecution are now included in Section IX, along with a statement setting forth where in the record that evidence was entered and considered by the Examiner.

I.	REAL PARTY IN INTEREST.....	3
II.	RELATED APPEALS AND INTERFERENCES.....	3
III.	STATUS OF CLAIMS.....	3
IV.	STATUS OF AMENDMENTS.....	3
V.	SUMMARY OF CLAIMED SUBJECT MATTER.....	3
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	5
VIII.	ARGUMENTS – REJECTIONS UNDER 35 U.S.C. § 103.....	5
	A. There is a clear error in the Examiner’s Final Rejection of claims 1-30 <u>1, 7, 12, 16, 22 and 27 because Walker et al. and in view of Shrader, either taken</u> <u>individually, or in combination, do</u> not disclose or suggest any of the steps (a)-(c) of claims 1 and 16, at least step (c) of claims 7 and 22, and at least step (a) of claims 12 and 27.....	5
	B. Summary of claim limitations <u>in claims 1, 7, 12, 16, 22 and 27</u> that are not disclosed or suggested by Walker et al. in view of Shrader.....	10
	C. Patentability of dependent claims <u>2, 4-6, 8-11, 13-15, 17, 19-21, 23-26</u> <u>and 28-30 over Walker in view of Shrader; and</u> <u>Patentability of dependent claims 3 and 18 over Walker in view of</u> <u>Shrader and NIS 2000.....</u>	12
	D. Applicants’ arguments do not stand or fall based on application of the CAFC’s nonobviousness doctrine using a motivation/suggestion/teaching test.....	12
	E. Conclusion.....	13
VIII.	APPENDIX OF CLAIMS.....	14
IX.	APPENDIX OF EVIDENCE.....	22
X.	APPENDIX OF RELATED DECISIONS.....	22
XI.	OTHER MATERIAL THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE.....	22

I. REAL PARTY IN INTEREST

This application is assigned to Ascentive LLC, by an Assignment recorded on March 28, 2001, at Reel No. 011662, Frame 0557. Accordingly, Ascentive LLC is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellants, their Assignee and their legal representatives are unaware of the existence of any related appeals and/or interferences that will directly affect, be directly affected by, or have a bearing on the decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-30 are pending in the instant application on appeal.

Claims 1-30 stand twice rejected as discussed below and are the subject of the instant appeal. The grounds of rejection in the Final Office Action dated November 21, 2006 were unclear. Accordingly, Applicants' undersigned representative telephoned the Examiner on December 7, 2006 to request clarification of the grounds. The Examiner stated that the § 102(e) rejection over U.S. Patent Application Publication No. 2002/0055912 (Buck) was ~~withdrawn~~, and that the only outstanding rejection is rejections are based on Walker et al. in view of Shrader, and Walker et al. in view of Shrader and Julien Jay (Norton Internet Security 2000). The Examiner further stated that all pending claims are rejected over this combination these combinations of references, even though the grounds of rejection on page 2 of the Office Action only refers to claims 1, 2 and 4-6.

The complete text of claims 1-30, as pending, is attached hereto in Appendix VIII.

IV. STATUS OF AMENDMENTS

No amendments were filed in the present application subsequent to the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following summary describes one preferred embodiment of the present invention. The scope of the present invention is not limited to the specific configuration or elements shown in the figures and described below.

Independent claim 1 recites a method of screening cookie files in a client machine (20), wherein a cookie file includes a cookie file source (page 3, lines 2-4; page 5, lines 18-19 and

lines 20-24.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 4-17 and 18-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (hereafter, “Walker”) in view of Shrader.

Claims 3 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Shrader and Julien Jay (Norton Internet Security 2000).

As discussed above, the Examiner clarified that all pending claims are rejected over these combinations of references, even though the grounds of rejection on page 2 of the Office Action only refers to claims 1, 2 and 4-6.

VIII. ARGUMENTS – REJECTIONS UNDER 35 U.S.C. § 103

A. There is a clear error in the Examiner’s Final Rejection of claims 1-301, 7, 12, 16, 22 and 27 because Walker and in view of Shrader, either taken individually, or in combination, do not disclose or suggest any of steps (a)-(c) of claims 1 and 16, at least step (c) of claims 7 and 22, and at least step (a) of claims 12 and 27

i. Background to Applicants’ Invention

The following text portion from page 2, lines 19-30 of the present specification highlights one of the deficiencies in the prior art that the presently claimed invention addresses:

There are software programs that let users create a profile of which types of cookie files they will accept. However, there is no guarantee that cookie files generated by companies with a history of abusing the use of cookie files will be screened out, nor is there a universal reference source for determining which cookie file sources should not be accepted. What is needed is a professional service that constantly researches and evaluates cookie file sources (e.g., websites), cookie files, consumer complaints and other statistical data, and develops and electronically distributes to subscribing computer users, on a periodic basis, a list of those cookie file sources that the service recommends should not be permitted to store cookie files in the subscribing user’s computer. What is also needed is a user-friendly interface for enabling a user to easily and automatically modify the distributed list once it is received by the user’s computer, such that the user may customize the list to meet his or her individual or organizational requirements.

Claims 1 and 716 are directed to the broad process for screening cookie files in a client machine by using a list of cookie file sources that is maintained by a server (e.g., the professional service referred to above that maintains a universal reference source) and downloaded to the client machine. Claims 7, 12, 22 and 27 are directed to a process for user editing of the list. Neither of the applied references disclose or suggest either of these claimed processes.

ii. Walker

Walker discloses a browser that is capable of accessing only web pages previously authorized by a parent or supervisor of a user of the browser. In a supervisor mode of operation, a parent can browse through any accessible web site and continually add approved web sites to a database of authorized web sites. Later, in a user mode of operation, the child is capable of accessing only those web sites that have been added to the authorized web site database. As described on column 11, lines 25-36 of Walker, the database of authorized web sites may be pre-populated with an initial pre-approved list of child-appropriate URL's that are downloaded from a remote server. The parent can then manually add more web sites to the list.

Numerous other previously applied references disclose downloading lists of child-safe websites. See, for example, the Norton Internet Security 2000 ("NIS 2000") Black web site list discussed on page 3 of the Response filed April 11, 2006 (mail date of April 6, 2006). As previously argued, this is not Applicants' invention because a list of web sites is not a list of cookie file sources. In fact, a list of web sites might not include any cookie file sources. Furthermore, the purpose of downloading a list of web sites is different than the purpose of downloading a list of cookie file sources. The purpose of downloading a list of web sites, as described in Walker or NIS 2000 is to allow users to block access to such sites. The purpose of downloading a list of cookie file sources, in one preferred embodiment of the present invention, is to prevent certain cookie files from becoming stored on a user machine, or to delete such cookie files if they were previously stored. Access to the website associated with the cookie file is not necessarily blocked.

In the Final Rejection, the Examiner states that Walker discloses a client machine that requests a "list of sources" and a server that downloads a "list of sources" to the client machine. Throughout the entire prosecution history of this patent application, which has included seven Office Actions and a myriad of different prior art rejections, no prior art reference has been cited

iv. Walker in view of Shrader

Shrader is directed to a completely different problem in the art as Walker. However, Shrader and Walker appear to be compatible references. The combination of Walker and Shrader would provide a web site blocking tool that would also allow a user to provide enhanced cookie control for the web sites that are not blocked by Walker's process. Such a combination, however, would still not disclose or suggest the claimed invention.

B. Summary of claim limitations in claims 1, 7, 12, 16, 22 and 27 that are not disclosed or suggested by Walker in view of Shrader, or Walker in view of Shrader and NIS 2000

For at least the reasons discussed above, none of the references applied against the independent claims disclose or suggest at least the following underlined limitations:

1. A method of screening cookie files in a client machine, wherein a cookie file includes a cookie file source, the method comprising:

- (a) receiving, at a server, a request from a subscriber to send a list of cookie file sources to the client machine;
- (b) downloading the list of cookie file sources from the server to the client machine; and
- (c) using the downloaded list of cookie file sources to detect cookie files received at the client machine from cookie file sources on the downloaded list by comparing the cookie file source of any received cookie file to the cookie file sources on the downloaded list.

7. A method of creating a composite list of cookie file sources in a client machine, the method comprising:

- (a) creating a first exception list including the identity of cookie file sources that are permitted to store cookie files in the client machine, wherein a cookie file includes a cookie file source;
- (b) creating a second exception list including the identity of cookie file sources that are not permitted to store cookie files in the client machine;
- (c) receiving at the client machine, from a service provider, a master list of cookie file sources; and
- (d) modifying the master list in accordance with the first and second exception lists, wherein the composite list is the modified master list.

12. A method of creating a composite list of cookie file sources in a client machine, the method comprising:

- (a) receiving at the client machine, from a service provider, a master list of cookie file sources;
- (b) deleting cookie file sources from the master list that correspond to one or more trusted cookie file sources listed in the client machine; and

Furthermore, the unique combination of steps (a)-(c) in claims 1 and 16; steps (a)-(d) in claims 7 and 22; and steps (a)-(c) in claims 12 and 27 are not disclosed or suggested by the applied references.

In view of the above remarks, claims 1, 7, 12, 16, 22 and 27 are believed to be patentable over Walker in view of Shrader.

C. Patentability of dependent claims 2, 4-6, 8-11, 13-15, 17, 19-21, 23-26 and 28-30 over Walker in view of Shrader; and
Patentability of dependent claims 3 and 18 over Walker in view of Shrader and NIS 2000

The dependent claims are believed to be patentable over the applied references for at least the reason that they are dependent upon allowable base claims and because they recite additional patentable elements and steps.

Regarding dependent claims 3 and 18, NIS 2000 does not make up for any of the above-highlighted deficiencies in Walker or Schrader.

D. Applicants' arguments do not stand or fall based on application of the CAFC's nonobviousness doctrine using a motivation/suggestion/teaching test

According to this CAFC test, when various pieces of prior art each contain elements of an invention, the prior art can be combined together to invalidate a patent on the invention only when there is some motivation, suggestion, or teaching to combine the prior art. The U.S. Supreme Court has granted a *writ of certiorari* in KSR International Co. v. Teleflex Inc. (Fed. Cir. 2006) to decide if the CAFC's motivation/suggestion/teaching test is legally correct in view of Supreme Court precedent. Commentators expect the Supreme Court to decide if the CAFC test is consistent with the Supreme Court's test in Sakraida v. Ag Pro, Inc. 425 U.S. 273 (1976). In Sakraida, the arrangement of old elements with each performing the same function it had been known to perform in the prior art was deemed to be not patentable, even though the novel arrangement perhaps produces a more striking result than in previous combinations. Sakraida is considered to be a case where patentability of a new combination was denied, even though there was no explicit motivation, suggestion, or teaching to combine the old elements.

Here, patentability of the claimed invention does not rely solely upon the motivation/suggestion/teaching test because the combination of references still lacks any disclosure of at least steps (a) and (b) of claims 1 and 16, step (c) of claims 7 and 22, and step (a) of claims 12 and 27. Accordingly, these claims are believed to be patentable even under the

IX. APPENDIX OF EVIDENCE

——— No evidence has been included.

A copy of a § 1.131 Declaration filed April 6, 2007 (entered on April 11, 2006) is attached as Evidence Appendix A and a copy of a 1.131 Declaration filed November 9, 2006 is attached as Evidence Appendix B. These Declarations were submitted to overcome a rejection over Buck '912. These Declarations were considered by the Examiner in the Office Actions dated May 15, 2006 and November 21, 2006. As discussed above, in a telephone call on December 7, 2006, the Examiner clarified that the § 102(e) rejection over U.S. Patent Application Publication No. 2002/0055912 (Buck) was withdrawn in the November 21, 2006 Office Action.

Regarding 37 CFR § 41.37(c)(ix), these Declarations were not “relied upon by appellant in the appeal” because the Examiner withdrew the rejection over Buck. However, these Declarations are being provided because they were requested in the “Order Returning Undocketed Appeal to the Examiner.”